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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,754	03/23/2004	Silke Wolff	2124A	2419

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103 East Neck Road
Huntington, NY 11743

EXAMINER

BOLDEN, ELIZABETH A

ART UNIT	PAPER NUMBER
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1793

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01/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/806,754	WOLFF ET AL.	
	Examiner	Art Unit	
	ELIZABETH A. BOLDEN	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 October 2008.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3,5,6 and 16-27 is/are pending in the application.

4a) Of the above claim(s) 5,6 and 21-27 is/are withdrawn from consideration.

5) Claim(s) 17-19 is/are allowed.

6) Claim(s) 1-3,5,6 and 16-27 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. 10/137,930.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/19/08 & 12/5/08.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/137,930, filed on 10 July 2002. Applicants are requested to update the status of the parent application in the continuing data.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 19 August 2008 and 5 December 2008 have been considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shizuo et al., German Patent 3130715.

In reciting this rejection, the examiner will cite the Derwent Abstract 1982-16006E previously supplied.

Shizuo et al. teach an optical glass having overlapping components with instant claim 16. See Derwent Abstract. Shizuo et al. teach ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe number ranges in instant claims 1 and 2. See Abstract.

Shizuo et al. fail to teach any examples or compositional ranges that are sufficiently specific to anticipate the compositional limitations of claims 1-3 and 16. Shizuo et al. does not teach the density and spectral transmission purity degree and partial dispersion properties of the

glass as recited in claims 1 and 16. However, overlapping ranges have been held to establish prima facie obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to establish prima facie obviousness. See MPEP 2144.05.

One of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same density, spectral transmission purity degree, and partial dispersion properties recited in claims 1 and 16.

Claims 1-3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumaru et al., Japanese Patent Publication 61-163138.

In reciting this rejection, the examiner will cite the Derwent Abstract 1986-234732 previously supplied.

Matsumaru et al. teach an optical glass having overlapping components with instant claim 16. See Derwent Abstract. Matsumaru et al. teach ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe number ranges in instant claims 1 and 2. See Derwent Abstract.

Matsumaru et al. fail to teach any examples or compositional ranges that are sufficiently specific to anticipate the compositional limitations of claims 1-3 and 16. Matsumaru et al. does not teach the density and spectral transmission purity degree and partial dispersion properties of the glass as recited in claims 1 and 16. However, overlapping ranges have been held to establish prima facie obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to establish prima facie obviousness. See MPEP 2144.05.

One of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same density, spectral transmission purity degree, and partial dispersion properties recited in claims 1 and 16.

Claims 1-3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi et al., U.S. Patent 4,118,238.

Ishibashi et al. teach an optical glass having overlapping components with instant claim 16. See abstract and column 2, lines 30-51. Ishibashi et al. teach ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe number ranges in instant claims 1 and 2. See abstract and column 3, lines 12-14.

Ishibashi et al. fail to teach any examples or compositional ranges that are sufficiently specific to anticipate the compositional limitations of claims 1-3 and 16. Ishibashi et al. does not teach the density and spectral transmission purity degree and partial dispersion properties of the glass as recited in claims 1 and 16. However, overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

One of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same density, spectral transmission purity degree, and partial dispersion properties recited in claims 1 and 16.

Claims 1-3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al., U.S. Patent 4,226,627.

Inoue et al. teach an optical glass having overlapping components with instant claim 16. See column 1, lines 40-59. Inoue et al. teach ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe number ranges in instant claims 1 and 2. See column 1, lines 35-40.

Inoue et al. fail to teach any examples or compositional ranges that are sufficiently specific to anticipate the compositional limitations of claims 1-3 and 16. Inoue et al. does not teach the density and spectral transmission purity degree and partial dispersion properties of the

glass as recited in claims 1 and 16. However, overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

One of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same density, spectral transmission purity degree, and partial dispersion properties recited in claims 1 and 16.

Claims 1-3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi et al., U.S. Patent 4,166,746.

Ishibashi et al. teach an optical glass having overlapping components and compositional ranges with instant claims 16 and 19. See abstract and column 2, lines 54-68. Ishibashi et al. teach ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe number ranges in instant claims 1 and 2. See abstract and column 1, lines 29-37.

Ishibashi et al. fail to teach any examples or compositional ranges that are sufficiently specific to anticipate the compositional limitations of claims 1-3 and 16. Ishibashi et al. does not teach the density and spectral transmission purity degree and partial dispersion properties of the glass as recited in claims 1 and 16. However, overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

One of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same density, spectral transmission purity degree, and partial dispersion properties recited in claims 1 and 16.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato, U.S. Patent 6,413,894.

Sato teaches an optical glass having overlapping components and compositional ranges with instant claim 20. See abstract and column 7, lines 1-27. Sato teaches ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe number ranges in instant claim 20. See abstract and column 4, lines 45-55.

Sato fails to teach any examples or compositional ranges that are sufficiently specific to anticipate the compositional limitations of claim 20. Sato does not teach the density of the glass as recited in claim 20. However, overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

One of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same density as recited in claim 20.

Response to Arguments

Applicant's arguments see pages 24-28 filed 2 October 2009 with respect to the rejection(s) of claim(s) 1-3 and 16 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a different interpretation of the previously applied reference. In the instant cases the rejection has been changed to a 103(a) rejection due to the fact the compositional ranges of the above cited references all have overlapping ranges with the instantly rejected claims. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Applicants' argue that the glasses of the prior art do not teach the density of the glasses.

However, as rejected above the glasses do have overlapping ranges of components. Therefore, it is well settled that when a claimed composition appears to be substantially the same as a composition

taught in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

Any showing of evidence showing that the property of the instant claims is not present in the cited prior art must be commensurate with the scope of the instant claims to overcome this rejection.

Allowable Subject Matter

Claims 17-19 are allowed.

Reason for Allowance

The following is an examiner's statement of reasons for allowance:

The prior art fails to disclose or suggest the restriction of requiring the optical element to have an optical glass consisting only of the recited components in the recited amounts as limited in the instant claim renders these claims allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH A. BOLDEN whose telephone number is (571)272-1363. The examiner can normally be reached on 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth A. Bolden/
Elizabeth A. Bolden
Examiner
Art Unit 1793

EAB
6 January 2009

/Karl E Group/
Primary Examiner, Art Unit 1793